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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,400	11/04/2003	Peter A. Quigley	FPY-048.04	5827

25181 7590 11/08/2004

FOLEY HOAG, LLP  
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BOSTON, MA 02110

EXAMINER
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COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/700,400	QUIGLEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Elizabeth M. Cole	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/2/04.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1771

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claim 1 of U.S. Patent No. 6,016,845 in view of Charboneau, U.S. Patent No. 5,551,484. Although the conflicting claims are not identical they are not patentably distinct from each other because each discloses a composite tubular member which may include an energy conductor. U.S. '845 differs from the claimed invention because it does not disclose a sensor. Charboneau discloses a lining for pipelines which may include an optical fibers which is in the liner for purposes of monitoring stress or for communication, and which further comprises a capacitance leak detection circuit in the liner. Charboneau teaches that the optical fibers can be connected to a stress detector to monitor the liner when it is installed in a pipeline. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated optical fibers for the purpose of monitoring stresses in the tubular member of U.S. '845, motivated by the expectation

that this would enable pipelines which employed the liners to be monitored for possible problems.

3. Claims 1-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 at least of U.S. Patent No. 6,148,844 in view of Charboneau, U.S. Patent No. 5,551,484. Although the conflicting claims are not identical they are not patentably distinct from each other because each discloses a composite tubular member which may include an energy conductor. U.S. '884 differs from the claimed invention because it does not disclose a sensor. Charboneau discloses a lining for pipelines which may include an optical fibers which is in the liner for purposes of monitoring stress or for communication, and which further comprises a capacitance leak detection circuit in the liner. Charboneau teaches that the optical fibers can be connected to a stress detector to monitor the liner when it is installed in a pipeline. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated optical fibers for the purpose of monitoring stresses in the tubular member of U.S. '844, motivated by the expectation that this would enable pipelines which employed the liners to be monitored for possible problems.

4. Claims 1-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,707,348 in view of Charboneau, U.S. Patent No. 5,551,484. Although the conflicting claims are not identical they are not patentably distinct from each other because each discloses a composite tubular member which may include an energy conductor. U.S. '348 differs

Art Unit: 1771

from the claimed invention because it does not disclose a sensor. Charboneau discloses a lining for pipelines which may include an optical fibers which is in the liner for purposes of monitoring stress or for communication, and which further comprises a capacitance leak detection circuit in the liner. Charboneau teaches that the optical fibers can be connected to a stress detector to monitor the liner when it is installed in a pipeline. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated optical fibers for the purpose of monitoring stresses in the tubular member of U.S. '348, motivated by the expectation that this would enable pipelines which employed the liners to be monitored for possible problems.

5. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

6. The terminal disclaimer filed on 9/2/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patents 6,706,348; 6,361,299 and 6,004,639 have been reviewed and is accepted. The terminal disclaimer has been recorded.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1771

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.

A handwritten signature in black ink, appearing to read "Elizabeth M. Cole".

Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771

e.m.c